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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/785,992 | 02/16/2001 | Calvin L. Shoemaker | | 1679 |

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EXAMINER

ESTRADA, ANGEL R

ART UNIT PAPER NUMBER

2831

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/785,992 | Applicant(s) SHOEMAKER, CALVIN L. | |
| | Examiner Angel R. Estrada | Art Unit 2831 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on ____.

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-16 is/are pending in the application.

4a) Of the above claim(s) ____ is/are withdrawn from consideration.

5) ☐ Claim(s) ____ is/are allowed.

6) ☒ Claim(s) 1-12 and 14-16 is/are rejected.

7) ☒ Claim(s) 13 is/are objected to.

8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. ____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 line 1, "the rigid elements", lack antecedent basis.

Any further rejection of claim 10 in this office action is based on claim 10, as it is understood by the examiner.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-9 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-9 of prior U.S. Patent No. U.S. 6,222,125. This is a double patenting rejection.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 10 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. 6,222,125. Although the conflicting claims are not identical, they are not

patentably distinct from each other because claim 10 of US Patent No. 6,222,125 discloses the claimed plus a limitation that states that the electrical plug access the female element, *when the rigid extension are urged apart thus allowing the rigid extension to make contact with the metal prong of the plug thereby completely protecting a person from shock from the electrical outlet.* It would have been obvious to one having ordinary skill in the art at the time the invention was made to omit this limitation, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

4. Claim 11 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,222,125. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 10 of US Patent No. 6,222,125 discloses the claimed except for the covering extensions being thin enough to allow flexibility and mechanical movement. It would have been an obvious matter of design choice to make the covering extension thin enough to allow flexibility and mechanical movement, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re. Rose*, 105 USPQ 237 (CCPA 1955).

5. Claim 12 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,222,125 in view of Engel et al (US 4,952,755, hereinafter Engel).

Regarding claim 12, claim 1 of U.S. Patent No. 6,222,125 discloses the claimed invention except for the faceplate containing channels that guide protrusion on the urging extensions. Engle teaches an apparatus for covering an electrical outlet comprising a faceplate (10) with urging extensions (28), said faceplate (10) containing channels (24) that guide protrusions (38) on the urging extensions (28) of the assemblies when the urging extension (28) are first pressed in one direction, such as against a wall, then squeezed together so that said protrusions (38) engage with said channels of the faceplate thus creating a locking/latching mechanism (see figure 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide to the invention of Claim 1 of U.S. Patent No. 6,222,125 with a faceplate containing channels that guide protrusion on the urging extensions as taught by Engle to create a locking/latching mechanism.

6. Claim 14 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,222,125 in view of Chang (US 6,193,539).

Regarding claim 14, claim 1 of U.S. Patent No. 6,222,125 discloses the claimed invention except the covering extensions of the movable assemblies containing nipples that fit into the holes of the male prongs of a plug thus

enabling the covering extensions to lock a plug into place. Chang teaches an apparatus having movable assemblies (12) with nipples (13) that fit into holes (32) of the male prongs of a plug (30) thus enabling the movable assemblies to lock the plug into place (see figure 4 and 5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide to the invention of Claim 1 of U.S. Patent No. 6,222,125 with the covering extension of the movable assemblies with nipples that that fit into the holes of the male prongs of a plug thus enabling the covering extensions to lock a plug into place as taught by Chang.

7. Claim 15 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,222,125. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of US Patent No.6, 222,125 discloses the claimed plus a thin layer of insulating material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to omit the thin layer of insulating material, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. In re Karlson, 136 USPQ 184.

Claim 16 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,222,125. Although the conflicting claims are not identical, they are not

patentably distinct from each other because claim 15 of US Patent No. 6,222,125 discloses the claimed except for an additional spacer added between said apparatus and wall. It would have been an obvious matter of design choice to add more space between the apparatus and a wall to compensate for excessively protruding sockets, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re. Rose, 105 USPQ 237 (CCPA 1955).

Allowable Subject Matter

8. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: The primary reason for the indication of the allowability of claim 13 is:

Regarding claim 13 is the inclusion therein in combination as currently claimed of the limitation of the faceplate having a hump that extends therefrom that guard against finger access to the electrical outlet.

This limitation was found in claim 13, and is neither disclosed nor taught by the prior art of record, alone or in combination.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Crofton (US 5,113,045), Barla (US 5,240,426), Blaess (US 6,545,218), Setecka (US 3,317,881), Thomas (US 4,607,136), Ray et al (US 4,618,740), Hill (US 4,640,564), Wolfe-Taylor et al (US 4,733,017), Bruce (US 5,288,945), Fontaine (US 4,737,599) and Patterson, Jr. (US 5,998,735) disclose an apparatus for covering an electrical outlet to protect a person against electrical shock. May (US 4,820,187) and Chang (US 5,984,700) discloses a device for locking male prong of a plug.


10. Any inquiry concerning this communication should be directed to Angel R. Estrada at telephone number (703) 305-0853. The Examiner can normally be reached on Monday-Friday (8:30 -5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (703) 308-3682. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

AE

Novembre 14, 2003


DEAN A. REICHARD
SUPERVISORY PATENT EXAMINER
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